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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,337	08/25/2000	KI-QUANG WU	104107-01	5854

28944 7890 03/17/2003

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EXAMINER

MEHIL A. ASHWIND

ART UNIT	PAPER NUMBER
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1638

DATE MAILED 03/17/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/645,337

Applicant(s)

WU ET AL.

Examiner

Ashwin Mehta

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 31.

Claim(s) objected to: _____

Claim(s) rejected: 1-9, 11-19, 29 and 30.

Claim(s) withdrawn from consideration: _____

8. ☒ The proposed drawing correction filed on 20 February 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: See Continuation Sheet


Continuation of 2. NOTE: The specification does not recite all of the specific nucleotide sequences in the amended claims and new claims. There is no discussion in the specification about the specific nucleotide sequences 49-267 and 457-534 of SEQ ID NO: 5, 61-855 of SEQ ID NO: 7, 61-655 of SEQ ID NO: 7, 61-276 of SEQ ID NO: 7, and 522-655 of SEQ ID NO: 7. The recitation of these specific sequences constitutes new matter, as the specification does not describe these specific fragments, or that they retain the activity of the respective coding sequences from which they were derived. Further consideration would also be required concerning enablement of these newly claimed fragments. Amended claim 1 also introduces an indefinite issue, wherein the first line of the claim indicates that the claimed method is for repressing transcription, but the last line broadly recites "exhibits repression of gene expression activity," which encompasses more than only transcription repression.

Regarding the sequence listing submitted 20 February 2003: the response indicated that SEQ ID NO: 7 has been amended such that it now sets forth a sequence that is identical to the sequence depicted in Figure 2B as originally filed (page 13, 1st paragraph). However, the differences in the new sequence were not pointed out. The number and nature of the changes are unknown. As the changes are unknown, a new search may be necessary. Given the uncertainty, the new sequence listing has not been entered. As the amendments to the specification at page 7 reflect the changes to the sequence listing, the amendment to the specification has not been entered either.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claims 9, 11-13, 17-19, and 29 under 35 U.S.C. 112, 2nd paragraph, and claims 1-3, 5-8, and 14-16 under 35 U.S.C. 103(a).

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's response does not overcome the rejections under 35 U.S.C. 112, 1st paragraph, for lack of written description and enablement. Applicants argue that amended claims 1 and 9 recite specific nucleotide sequences that are explicitly supported by the specification, and are defined by both structure and function (response, page 14, 3rd full paragraph). However, the specification does not recite all of the specific nucleotide sequences in the amended claims and new claims. There is no discussion in the specification about the specific nucleotide sequences 49-267 and 457-534 of SEQ ID NO: 5, 61-855 of SEQ ID NO: 7, 61-655 of SEQ ID NO: 7, 61-276 of SEQ ID NO: 7, and 522-655 of SEQ ID NO: 7. The recitation of these specific sequences constitutes new matter, as the specification does not describe these specific fragments, or that they retain the activity of the respective coding sequences from which they were derived. Further consideration would also be required concerning enablement of these newly claimed fragments. Furthermore, while the Office action mailed 08 May 2002 raised the enablement issue that histone deacetylation results in repression of transcription and that the specification does not teach the involvement of histone deacetylases in any other manner of regulating gene expression, the amended and new claims encompass any manner of repressing gene expression.

Continuation of 10. Other: In the Request For Approval Of Drawing Corrections, submitted 20 February 2003, Applicants indicated that upon approval of the drawing corrections by the Examiner, that formal drawings will be corrected upon allowance of the application. Applicants are reminded that drawing corrections cannot be held in abeyance. See 37 CFR 1.85 and the back of Form PTO-948, attached to the Office action mailed 20 November 2002, and item 3 of the Office action mailed 08 May 2002.



ASHWIN D. MEHTA, PH.D
PATENT EXAMINER